

REMARKS

Claims 104-112 and 121-126 are pending in the application. The applicants note with appreciation the examiner's entry of the RCE of 9/17/03, consideration of the Rule 131 declaration, and the withdrawal of the 35 U.S.C. § 112 second paragraph rejection of claim 109 from the previous response. Claims 104-112 and 121-126 are indicated in the instant Office action as being unpatentable under 35 U.S.C. § 103(a) over Fredlund et al. ("Fredlund") (U.S. Patent No. 5,666,215) in view of Morris et al. ("Morris") (U.S. Patent No. 5,153,936). The applicants respond as follows.

CLAIMS 104-112 AND 121-126 MEET THE REQUIREMENTS OF SECTION 103(a)

The Office action states that claims 104-112 and 121-126 are not in compliance with 35 U.S.C. § 103(a) because, it is alleged, these claims recited inventions that are unpatentable over the combination of Fredlund in view of Morris. The applicants submit that the inventions set forth in these claims meet the requirements of § 103(a), respectfully traverse the allegations of the Office action and request reconsideration.

It is asserted in the Office action that Fredlund teaches all of the limitations of claims 104 and 121 except the means for notifying an authorized user. Fredlund is not only deficient as a reference in this regard, it is further deficient as failing to teach or suggest other limitations of at least claims 104 and 121.

An electronic storage facility as recited by either claim 104 or claim 121 encompasses "that the high resolution digital images of the first image provider can only be accessed by authorized users identified by the first image provider..." Fredlund does not teach or suggest that an authorized user accesses the high resolution copy of the digital image. Moreover, Fredlund teaches that access to the digital images is authorized and created by the photodeveloper, not the image provider -- "Responding to instructions 29 and using appropriate identification, the customer ... is able to access the low resolution version of their digital image file..." (Col 4 ll 46-49). The access in Fredlund, when authorized, is limited to the low resolution version of the digital image file and the authorization is created and given by the photodeveloper, not the image provider.

Fredlund does not teach or suggest each and every limitation of either claim 104 or 121; namely, it fails to teach or suggest means for notifying an authorized user, access by an authorized user to the high resolution image and authorization to access the high resolution image provided by the image provider. Therefore, Fredlund fails to anticipate or render unpatentable the inventions recited by claims 104 and 121.

Acknowledging that at least one deficiency of Fredlund, although as noted above there are several, the Office action states that Morris teaches notifying an authorized user identified by the first image provider that the authorized user has been authorized to download a low resolution copy of the high resolution digital image, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy to the authorized user. Morris does not teach such a process. Morris teaches scanning an image on a personal computer with a scanner and storing the image on an external disk drive, known at the time as DASD (data acquisition and storage device). Morris uses high and low resolution images to reduce, in some situations, the volume of data moved between the personal computer and the DASD. The applicants fail to find any reference to notifying a user, authorized or other. Notification is not taught in Morris, nor would one expect it because the system disclosed in Morris does not use a network to connect multiple users, but rather describes a single workstation coupled to a storage device. Morris further does not discuss the mechanism for locating stored information on the personal computer or DASD, so addressing using at least a portion of a pathname is not discussed.

Because Fredlund alone fails to teach or suggest each and every limitation of claims 104 and 121, it fails to anticipate or render unpatentable the inventions recited by these claims. Morris does not teach notification, and therefore, the combination of Fredlund and Morris, as alleged in the Office action, fails to teach each and every limitation of claims 104 and 121. Moreover, even if Morris taught notification, which as the applicants have discussed above it does not, Morris fails to teach or suggest all of the limitations lacking from Fredlund. Thus, again, the combination of Fredlund and Morris fails to teach each and every limitation of claims 104 and 121, and therefore, the inventions recited by claims 104 and 121 are patentable and claims 104 and 121 are allowable.

In view of the allowability of claims 104 and 121, claims 105-107, dependent either directly or indirectly from claim 104, are allowable over the cited references.

Claim 108 is alleged not to be allowable under 35 U.S.C. § 103(a) because of the combination of Fredlund in view of Morris. Under the same rational as applied against claim 108, claims 111, 124 and 126 are also alleged not to be allowable over the combination of Fredlund and Morris. As the applicants have demonstrated above in connection with claims 104 and 121, the combination of Fredlund and Morris fails to teach or suggest at least the limitations of authorization of users by the image provider and notification. Therefore, the combination of Fredlund and Morris does not teach each and every limitation respectively set forth in claims 108, 111 or 126. Thus, claims 108, 111, 124 and 126 are allowable over the cited references. Likewise, claims 109 and 110, dependent from claim 108, are allowable.

Claims 112 and 122 are alleged not to be allowable based upon the combination of Fredlund and Morris. For at least the reasons set forth above, these claims are allowable. Fredlund, as discussed above, at least does not teach authorized users that are identified by the first image provider and transmitting a portion of a pathname to the at least one user identified by the first digital image provider. Morris, as discussed above, also does not teach these limitations. Therefore, the combination of Fredlund in view of Morris fails to teach each and every limitation of claims 112 and 122. Thus, claims 112 and 122 are allowable.

Claim 123 is alleged not to be allowable based upon the combination of Fredlund and Morris as applied to claim 104. As discussed above, there is no teaching or suggestion in Fredlund of the image provider authorizing users. For at least this reason, and for the other reasons discussed above, Fredlund alone and the combination of Fredlund in view of Morris fail to teach each and every limitation of the claim. Therefore, claim 123 is allowable.

Claim 125 is alleged not to be allowable based upon the combination of Fredlund and Morris as applied to claims 104 and 121. As discussed above, there is no teaching or suggestion in Fredlund of the image provider authorizing users. For at least this

reason, Fredlund alone and the combination of Fredlund in view of Morris fail to teach each and every limitation of the claim. Therefore, claim 125 is allowable.

In view of the foregoing, all of the claims are allowable over the cited references, and such action is respectfully requested. The amendments to the claims are made for clarification of antecedent basis or for broadening their scope. None of the claims have been narrowed in view of prior art.

The Examiner is respectfully requested to pass this application to issue. If the examiner wishes to discuss any aspect of this response or the case in general, she is urged to contact the applicants' undersigned attorney. Should any additional fees be required, the Commissioner is authorized to charge or debit Deposit Account No. 13-2855.

Dated: April 12, 2004

Respectfully submitted,

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